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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/876,883      | 06/07/2001  | Hideo Ujihara        |                     | 7820             |

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EXAMINER

COLE, MONIQUE T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1743

DATE MAILED: 09/17/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/876,883

Applicant(s)

UJIHARA ET AL.

Examin r

Monique T. Cole

Art Unit

1743

-- The MAILING DATE of this c mmunication appears on the cover sheet with the corresp ndence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 12 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Information Disclosure Statement*

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3-5 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is currently written as a compound claim that has a mixture of two components, namely 1a and 1b. Claims 4 and 5 are directed to a mixture of the compounds recited in claim 3 in particular percentages. A compound claim is conventionally drafted to include only one

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compound, and thus the current claim does not fall within the usual parameters of a compound claim. It is thought that Applicant is attempting to claim a racemic mixture of 1a and 1b. Therefore, instant claim 3 must be rewritten as composition claim rather than a compound claim.

Claim 13 is rendered indefinite because of the use of the trademarks Amberlyst-15 and Nafion H. If a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 USC 112, second paragraph. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. Correction is required. See MPEP 2173.05(u).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

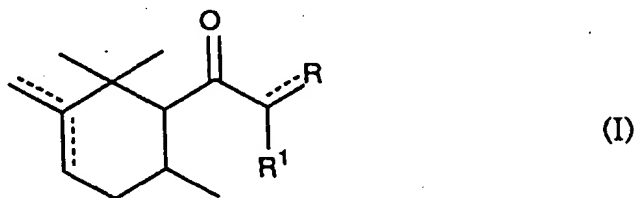
6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1, 2, 3, 6, 7 & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 676393 to Blanc et al. (herein referred to as "Blanc").

Blanc discloses a compound of formula I and its optical isomers wherein  $R^1 = H$  and  $R = H$ .



The compound disclosed in Blanc has utility as a perfume compound and may be present in perfumes, toilet water, soaps, etc.

In this configuration, the compound disclosed by Blanc differs from the instantly claimed compound in that the cyclohexyl ring contains an additional methyl substituent & the reference does not explicitly teach the specific isomeric form instantly claimed.

However, a *prima facie* case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. In the instant case, both the claimed compound and the disclosed compound have utility in the fragrance art. An obviousness rejection based on similarity in chemical structure and function entails the requisite motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.

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Thus, while Blanc may not explicitly disclose the (1S, 6R) and (1R, 6S) isomeric configuration of the cyclohexyl ring, given the similar utility of the claimed compound to the Blanc compound, it would have been obvious to one of ordinary skill in the art to make the claimed compound with the expectation of it having similar fragrancng capability. Moreover, although the instantly claimed compound is missing one of the methyl substituents disclosed by Blanc, one of ordinary skill in the art would not expect a substantial difference between the two compounds, as compounds differing only by one methyl group are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties (i.e., functionally equivalent perfumes). See MPEP 2144.09; *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers *prima facie* obvious). Therefore, for the reasons set forth above, Applicant's claimed invention is deemed to be obvious, within the meaning of 35 USC 103, over Blanc.

*Allowable Subject Matter*

8. Claims 4, 5 & 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 11, 12 & 14 are allowed.

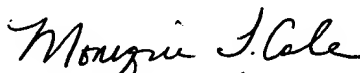
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11. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest the (1S, 6R) and (1R, 6S) isomeric configuration of 2,2,6-trimethylcyclohexyl methyl ketone in the optical purity percentages as recited in claims 4, 5, 9 and 10. Also, the prior art does not teach or suggest the process for producing trans-2,2,6-trimethylcyclohexyl methyl ketone by cyclizing an enol acetate compound in the presence of an acid catalyst.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique T. Cole whose telephone number is 703-305-0447. The examiner can normally be reached on Monday-Thursday from 6:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0661.

  
Monique T. Cole  
Examiner  
Art Unit 1743

September 1, 2003  
MC